SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 716

INDUSTRIAL INSTRUMENT CORPORATION,
Petitioner,

v.

THE FOXBORO COMPANY,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION

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Question Presented

Did the District Court and Court of Appeals err in their concurrent findings that the alleged innovation of the patent in suit was "not new", "had long been in wide use", was "well known in the art", and even had been previously "conceived . . . and . . . used" by defendant-respondent itself, or in their consequent ruling that the claimed "subject matter as a whole would have been obvious . . . to a person having ordinary skill in the art"?

Statement of the Case

This action, originally brought for alleged infringement of five patents, has, in the course of two trials and

two appeals, been progressively narrowed to an assertion of only one claim of one patent.

Petitioner quotes and repeatedly refers to the statements of the Court of Appeals, in its opinion on the *first* appeal, to the effect that the one patent claim which now remains in suit covered a combination of old elements with one element which was apparently new, and that the claimed combination "accomplished a meritorious result by means not taught in the prior art."

However, petitioner neglected to inform this Court that when the Court of Appeals wrote that *first* opinion, it did not have before it *any* prior art applicable to the patent in question, because the District Court, following the first trial, had ruled that this patent had not been infringed by defendant-respondent and accordingly had found it unnecessary to pass upon its validity. When the Court of Appeals ruled the patent infringed under the "doctrine of equivalents," it therefore remanded the case to the District Court for a ruling as to the validity of the patent, expressly giving the District Court discretion to reopen the case for receiving evidence of prior art relative thereto.[1]

After such reopening, the District Court and the Court of Appeals both found that the alleged innovation was "not new" but "had long been in wide use" and was "well known in the art."[2]

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[1] E-9. The reason for the reopening was that, following the original trial, plaintiff-petitioner changed its theory as to the alleged innovation of the Reese patent No. 2,762,393. See A-4.

[2] Findings 2-5, D3-4; A2-3.

Petitioner has ignored these later findings, and instead has quoted only the tentative contrary statements made by the Court of Appeals *before* the relevant prior art had been introduced.

Argument

Petitioner argues that the District Court's ruling that the patented invention was "obvious . . . to a person having ordinary skill in the art",[3] although denominated a "finding of fact", was in reality a "conclusion of law", since it paraphrases the wording of 35 U. S. C. § 103.[4] Petitioner then urges that the Court failed to make the findings of fact necessary to support such a conclusion.

Petitioner's argument pointedly ignores other specific and detailed findings of fact by the District Court, which were expressly affirmed on appeal. For example, the District Court found that the only asserted innovation of the Reese patent in suit was, in fact, "not a new concept of Reese, but was disclosed by a number of prior patents" which were specifically enumerated,[5] and which the Court found to establish that the alleged innovation was "well known in the art."[6] The District Court further found that before the filing date of the patent in suit, defendant-respondent Foxboro "had conceived the same principle . . . and had used this principle in meters which had been successfully tested."[7] All of

[3] Finding 6, D4-5.
[4] Petition, p. 4.
[5] Findings 2 and 3, D3-4.
[6] Finding 4, D4.
[7] Finding 5, D4.

these findings were expressly affirmed by the Court of Appeals.[8]

By any definition, these are "findings of fact." And this Court has repeatedly ruled that it will not disturb such concurrent findings "if there is evidence to support them"[9] or "in the absence of a very obvious and exceptional showing of error."[10]

Petitioner has not even attempted to show any error in these findings. Indeed, it has avoided mentioning them at all in its petition.

Whether the District Court's ruling that the alleged invention of Reese was "obvious . . . to one having ordinary skill in the art" was a "finding of fact" or a "conclusion of law" is of not the slightest consequence. Even if it were a "conclusion", it would inevitably follow from the unchallenged findings of fact referred to above.

Since the patent in suit is clearly invalid on the ground of "obviousness" under 35 U. S. C. § 103,[11] it is unnecessary to consider petitioner's other arguments (1) that the District Court improperly ruled the patent invalid on the *additional* ground of "anticipation" as defined by 35 U. S. C. § 102,[12] and (2) that the Court of Appeals failed to pass upon petitioner's contention that

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[8] A2-3.

[9] *Williams Mfg. Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364, 367 (1942).

[10] *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U. S. 271, 275 (1949); see also *Universal Oil Products Co.* v. *Globe Oil Co.*, 322 U. S. 471, 473 (1944); *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, 278 (1944).

[11] Petition, p. 4.

[12] I1-2.

the District Court had not made sufficient findings of fact to support such a ruling of "anticipation."

Once the Court of Appeals had affirmed the District Court's ruling that the patent is invalid under Section 103, it obviously became unnecessary for the Court to consider whether the patent is *also* invalid under Section 102.

Conclusion

The petition represents nothing more than an attempt to obtain further appellate review[13] of findings of fact upon which the District Court and the Court of Appeals concurred—an attempt which rests entirely upon the naked technicality of an alleged misnomer of a "conclusion" as a "finding", a fancied error which could not possibly have affected the outcome of the case, and is not even alleged to have done so.

The petition should be denied.

Respectfully submitted,

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[13] Contrary to the repeatedly enunciated principle that the jurisdiction to grant review by way of certiorari ". . . was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing." *Magnum Co.* v. *Coty*, 262 U. S. 159, 163 (1923).